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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,903	11/27/2002	Hao-Hsing Lin	ALIP0012USA	5304

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EXAMINER

DOAN, DUYEN MY

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,903

Applicant(s)

LIN ET AL.

Examiner

Duyen M Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detail Action

Claims 1-18 are presented for examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim1, 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claim 1 and 9 disclosed "the master computer can directly access the portable storage device and the slave computer", The paragraphs that applicant cited to support these claims are merely state that "the master computer can access both portable storage device and the slave computer. In deciding whether the master device has direct connection to the slave storage, it would require further step to describe how the master connect to the slave.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, 9-12, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah (us pat 5784581) in view of Shires (us pat 5167028).

As regarding claims 1, 9 Hannah disclosed a non-volatile memory for storing data in the portable storage device (col.5, lines 60-63, Fig.4, Fig.6); a first slave port for connecting the portable storage device to the first slave computer through the serial bus interface (col.5, lines 31-52, Fig.4, Fig.6); and a master port for connecting the portable storage device to the master computer through the serial bus interface (col.5, lines 31-52, Fig.4, Fig.6). Hannah does not expressly disclose the master computer is capable of accessing data located on the portable storage device and storage apparatuses of the first slave computer and the first slave computer is not capable of accessing any data located on the portable storage device and the master computer. Shires teaches the master computer is capable of **directly** accessing data located on the portable storage device and storage apparatuses of the first slave computer (col.1, lines 23-26) and the first slave computer is not capable of accessing any data located on the portable storage device and the master computer (col.1, lines 32-34).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Shires with the device of Hannah to have the storage connect between the master and the slave, the master can access the slave, but the slave cannot access the master. The slave can performing task requested from the master computer and for the purpose of data security.

As regarding claims 2, 10 Hannah discloses a second slave port for connecting the portable storage device to a second slave computer through the serial bus interface (col.6, lines 4-5, connect to one or more slave devices). Hannah does not expressly disclose the master computer is capable of accessing data located on the second slave computer and the second slave computer is not capable of accessing any data located on the portable storage device, the first slave computer, and the master computer. Shires teaches the master computer is capable of accessing data located on the second slave computer and the second slave computer is not capable of accessing any data located on the portable storage device, the first slave computer, and the master computer (col.1, lines 32-34).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Shires with the device of Hannah to have the storage connect between the master and the slave, the master can access the slave, but the slave cannot access the master for the purpose of the slave can performing task requested from the master computer and for the purpose of data security.

As regarding claims 3, 11 the limitations are similar to claim 2, therefore rejected for the same rationale as claim 2.

As regarding claims 4, 12 Hannah discloses the serial bus interface is a universal serial bus (USB) interface (col.1, lines 61-62).

As regarding claims 8, 16 Hannah discloses the non-volatile memory is a flash memory (col.5, lines 60-62).

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As regarding claim 17-18, the limitations are similar to claim 1, therefore rejected for the same rationale as claim 1.

Claims 5, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah (us pat 5784581) and Shires (us pat 5167028) as applied to claim 1,9 above, and further in view of Smith et al us pat 6633933 (hereinafter Smith).

Hannah-Shires disclose all the limitation of claim 1 above but do not disclose the portable storage device of claim 4 being compatible with the USB Mass Storage Class Bulk-Only Transport specification. Smith teaches USB Mass Storage Class Bulk-only Transport specification (col.15, lines 11-15).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Smith with the system of Hannah-Shires to have the portable storage compatible with USB Mass Storage Class Bulk-only Transport specification for the purpose of USB transactions (see Smith col.15 lines 11-12).

Claims 6,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah (us pat 5784581) and Shires (us pat 5167028) as applied to claim 1 above, and further in view of Knight et al (US 2003/0163587) (hereinafter Knight).

Hannah-Shires disclose all the limitation of claim 1 above but do not disclose The portable storage device of claim 4 being compatible with the USB On-The-Go specification. Knight teaches the USB On-the-Go (page.2 paragraph 13).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Knight with the system of Hannah-Shires to have the

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portable storage compatible with USB On-the-Go for the purpose of offering on the go capability (see Kinght page.2, paragraph 14).

Claims 7, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah (us pat 5784581) and Shires (us pat 5167028) as applied to claim 1,9 above, and further in view of Deng et al (us pat 6829672) (hereinafter Deng).

Hannah-Shires disclose all the limitation of claim 1 above but do not disclose the serial bus interface is an IEEE 1394 interface. Deng teaches IEEE 1394 interface (see Deng col.6, lines 40-47).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Deng with the system of Hannah-Shires to have serial bus interface is an IEEE 1394 interface for the purpose of data exchange between the host machine and the external storage device (see Deng col.6, lines 45-47).

Response to Arguments

Applicant's arguments filed 7/4/05 have been fully considered but they are not persuasive.

As regarding to Applicant's argument on claim 1, "neither Hannah nor Shires teach the limitation of the amended claim 1 and 9, in which the master computer in capable of directly accessing data located on the first slave computer". Examiner disagrees, Applicant pointed out the that "These amendments are fully supported in the

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specification in paragraph 21, lines 4-13, and in paragraph 24, lines 9-16". These two paragraph that Applicant pointed out does not support the amended claim 1 the master computer in capable of directly accessing data located on the first slave computer. These paragraph merely stated that the server can access the portable storage device and the slave computer. No where in the specification disclosed the amended claim 1 that the master computer in capable of directly accessing data located on the first slave computer.

Examiner's claims' interpretation is under guideline, provided in the MPEP, "During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." > *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). < Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

"The words of a claim must be given their "plain meaning" unless they are defined in the specification. While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. > *In re American Academy of Science Tech Center*, ___ F.3d ___, 2004 WL 1067528 (Fed. Cir. May 13, 2004); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef*

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America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.” (Emphasis added).

“ It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). >See also *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004)”

For instance, the term will interpret in accordance with explicit definition, provided that the specification clearly sets forth the definition explicitly and reasonable clarity, deliberateness, and precision, (*In re Teleflex Inc. v. Ficosa North America corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord corp. v. Laitram corp.*, 60 USPQ2d, 1857, 1857 (Fed. Cir. 2001) and MPEP 2111.01.)

If the specification fails to meet the above condition, i.e., explicitly defined, the language of the claim should be consider in context of surrounding words and context of the specification as a whole, i.e., in light of the specification, (*In re Tex. Digital Sys., Inc. v. Telegeniox, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, (Fed. Cir. 2002).

“Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)(“In the absence of an express intent to impart a novel meaning to the claim

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terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard /Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003) (Dictionary definitions were used to determine the ordinary and customary meaning of the words "normal" and "predetermine" to those skilled in the art. In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor.); *ACTV, Inc. v. The Walt Disney Company*, 346 F.3d 1082, 1092, 68 USPQ2d 1516, 1524 (Fed. Cir. 2003) (Since there was no definition given for the term "URL" in the specification, the term should be given its broadest reasonable interpretation and take on the ordinary and customary meaning attributed to it by those of ordinary skill in the art; thus, the term "URL" was held to encompass both relative and absolute URLs.); and *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003) (Where no explicit definition for the term "electronic multi-function card" was given in the specification, this term should be given its ordinary meaning and broadest reasonable interpretation; the term should not be limited to the industry standard definition of credit card where there is no suggestion that

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this definition applies to the electronic multi-function card as claimed, and should not be limited to preferred embodiments in the specification.)” (Emphasis added).

After thoroughly consider applicant’s full disclosure, Examiner found no evidence that suggests examiner must read the term “directly” as applicant wishes. The term directly is defined in an online dictionary www.webster.com as “in immediate physical contact”. Since throughout the specification there is no slight suggestion that there is no suggestion that the master computer is “immediate physical contact” accessing the slave storage. Examiner interprets the term “directly access” as any accessing data between the master, the portable storage and the slave device. Examiner would give weight to the word “directly” if it was presented in the original specification. Applicant added the word “directly” to overcome the prior art rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

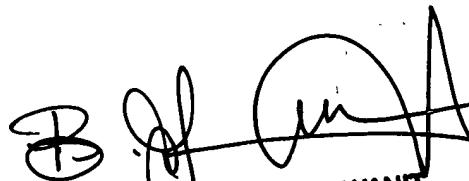
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Duyen Doan
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BUNJOS J. ARDENCHONWANTI
PRIMARY EXAMINER